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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,425	07/20/2001	James V. Tietz	55579USA2B	4868

33072 7590 03/08/2004

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

10

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,425

Applicant(s)

TIETZ, JAMES V.

Examiner

Hadi Shakeri

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Brief Description for each drawing should be provided, as it appears, Figs. 4 and 9 should be labeled as "Prior Art".

Appropriate correction is required.

Claim Objections

2. Claims 6 and 10 are objected to for being identical. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 7 recites the limitation "the marker" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 6-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al. (US 5,733,176).

Robinson et al. discloses all the limitations of claim 1, i.e., a fixed abrasive article comprising three dimensional abrasive composites elements (18, 10) and wear indicator (16).

Art Unit: 3723

Regarding claims 2, 3, 6-12 and 15, Robinson meets the limitations, e.g., wherein the abrasive article is "textured" pad, erodable, visible marker (dye) in the binder (10), coated and/or embedded on/in an abrasives surface.

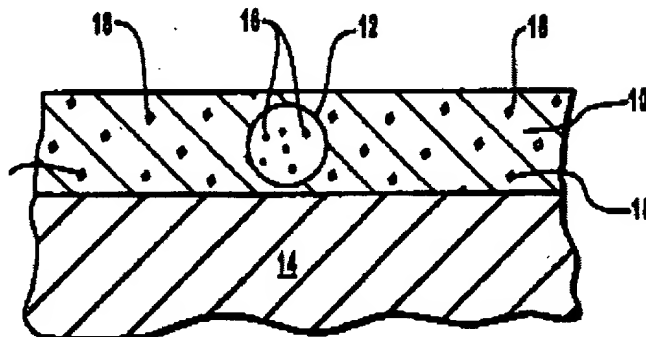
Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Robinson et al.

AAPA, e.g., references cited and incorporated, meets all the limitations of claim 1, except for disclosing a wear indicator. Robinson et al. teaches placing a wear indicator in the form of a chemical, physical and/or optical disposed in a void in the binder. It would have been obvious to one of ordinary



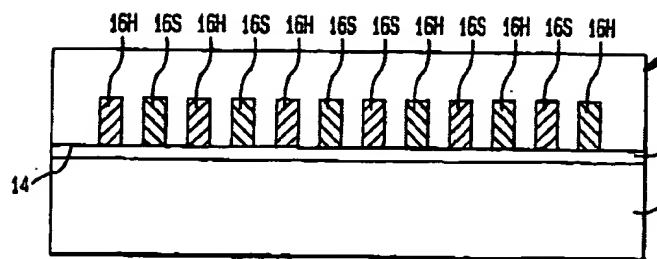
skill in the art, at the time the invention was made, to modify the invention of AAPA with the pad indicator as taught by Robison et al. to indicate the time for changing the pad.

10. Claims 1-18 are is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Cheek et al.

AAPA, e.g., references cited and incorporated, meets all the limitations of claims 1 and 17, except for disclosing a wear indicator, in the form of a post (claim 17). Cheek et al. teaches placing a post like wear indicator in the binder. It would have been obvious to one of ordinary

Art Unit: 3723

skill in the art, at the time the invention was made, to modify the invention of AAPA with the pad indicator as taught by Robison et al. to indicate the time for changing the pad.



Conclusion

11. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Raede et al., Rutherford et al. and Robinson et al. are cited to show related inventions.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. All official documents may be faxed to (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.

Hadi Shakeri
Patent Examiner
February 16, 2004